UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,433	10/31/2003	Thomas Arend	08516.0005	7747

22852 7590 08/01/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
COUGHLAN, PETER D	

ART UNIT	PAPER NUMBER
2129	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,433	AREND, THOMAS	
	Examiner	Art Unit	
	Peter Coughlan	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/2/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. This office action is in response to an AMENDMENT entered June 9, 2006 for the patent application 10/697433 filed on October 31, 2003.

2. The First Office Action of March 9, 2006 is fully incorporated into this Non-Final Office Action by reference.

Status of Claims

3. Claims 1-14 are pending.

35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 for nonstatutory subject matter. The computer system must set forth a practical application of that § 101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application. Solutions that are applied to solve a problem is

vague and not a practical application. The result has to be a practical application. Please see the interim guidelines for examination of patent applications for patent subject matter eligibility published November 22, 2005 in the official gazette.

In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete." If the claim is directed to a practical application of the § 101 judicial exception producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. § 101.

The phrase 'solutions are applied to solve the problem' are vague and not within a real world situation. Is the problem concerned with drug interaction, interest rates or automobile repair? Is so or some other example no such results have not been claimed.

The invention must be for a practical application and either:

1) specify transforming (physical thing) or

2) have the FINAL RESULT (not the steps) achieve or produce a

useful (specific, substantial, AND credible),

concrete (substantially repeatable/ non-unpredictable), AND

tangible (real world/ non-abstract) result.

A claim that is so broad that it reads on both statutory and non-statutory subject matter, must be amended, and if the specification discloses a practical

application but the claim is broader than the disclosure such that it does not require the practical application, then the claim must be amended.

The claims have to have a function or a purpose with the real world to have a practical application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 5-7, 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over August et al in view of Smith. (U. S. Patent 6647383, referred to as **August**; U. S. Patent 5317725, referred to as **Smith**)

Claim 1.

August teaches a main system to execute an application in cooperation with a human user and a remote service system to evaluate problems in the main system (**August,** C5:53-60; 'Human users' of applicant is equivalent to 'users' of

August. 'Remote service system' of applicant is equivalent to 'proxy server' of August.), the main system comprising a database (**August,** C7:14-37), an application server (**August,** C9:24-48; 'Application server' of applicant is equivalent to 'search application system' of August.)and a front-end server (**August,** C27:17-32), and the service system comprising: ,a service module configured, to collect problem related data from the main system. (**August,** C9:55-66; 'Service module' of applicant is equivalent to 'back end server' of August.)

August doers not teach said problem related data representing a problem identified about data in the main system.

Smith teaches said problem related data representing a problem identified about data in the main system. (**Smith,** C5:23-38; 'Problem identified about data in the main system' of applicant is equivalent to 'diagnosing data communications networks' of Smith.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of August by introduction the area of problem related data as taught by Smith to have a problem related data representing a problem identified about data in the main system.

For the purpose of determining if a problem is in database, application server or the front end server.

August teaches an acquisition module configured to acquire knowledge representations said knowledge representations defining solution identification rules (**August,** C9:66 through C10:27 C14:12-41; 'Acquire knowledge' of

applicant is preformed by 'learning engine' of August. 'Defining solution identification rules' of applicant is equivalent to 'definitions of important features' of August.), a knowledge module configured to store the knowledge representations (**August,** C9:66 through C10:27; 'store the knowledge representations' of applicant is preformed by 'learning engine' of August.), and an inference module configured to process problem related data with knowledge representations to identify solutions (**August,** C19:50 through C20:13; 'Inference module' of applicant is equivalent to 'smart search engine' of August.), and forward the solutions through the service module to the main system. (**August,** C19:50 through C20:13; In FIG #1 the 'smart search engine' forwards solutions through interfaces 26, 24 and 22 to the internet.)

August does not teach wherein the identified solutions are applied to solve the problem.

Smith teaches wherein the identified solutions are applied to solve the problem. (**Smith,** C30:1-9) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of August by instructing to perform the solutions to solve the problem as taught by Smith to have the identified solutions are applied to solve the problem.

For the purpose of correcting the problem.

Claim 3.

August teaches the service module (**August,** 'server back-end') monitors the application server (**August,** 'search application server') and the database

(**August,** FIG#1, 42, 46, 48, 50, 52, 58 and 62) according to instructions from the inference module. (**August,** 'smart search engine'; In FIG#1, the 'server back-end' encompasses the 'smart search engine' and 'search application system'. The 'server back-end' is adjacently linked to the databases, thus monitoring all three modules.)

Claim 5.

August teaches the service system, the inference module (**August,** C9:66 through C10:27; 'Inference module' of applicant is equivalent to 'smart search engine' of August.) is adapted to process problem (**August,** C9:66 through C10:27; 'Process problem' of applicant is equivalent to 'identify' of August.) related data with knowledge representations to identify solutions (**August,** C9:66 through C10:27; 'Identify solutions' of applicant is equivalent to 'locating' of August.) and to return solutions (**August,** C9:66 through C10:27; 'Return solutions' of applicant is equivalent to 'retrieving' of August.)to the main system, wherein the service system returns solutions that solve the problem directly in the main system. (**August,** C9:66 through C10:27; 'Directly' of applicant is equivalent to 'information database'. Directly meaning information that was already at hand and no input from an 'expert' was needed for further search.)

Claim 6.

August teaches the service system, the inference module (**August,** C9:66 through C10:27; 'Inference module' of applicant is equivalent to 'smart search

engine' of August.) is adapted to process problem (**August,** C9:66 through C10:27; 'Process problem' of applicant is equivalent to 'identify' of August.) related data with knowledge representations to identify solutions (**August,** C9:66 through C10:27; 'Identify solutions' of applicant is equivalent to 'locating' of August.) and to return solutions (**August,** C9:66 through C10:27; 'Return solutions' of applicant is equivalent to 'retrieving' of August.) to the main system, wherein the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module operating for the main system. (**August,** C9:66 through C10:27; 'Indirectly' of applicant is equivalent to 'expert knowledge database'. Indirectly meaning information that was not initially present at system start and learning engine generated a solution caused by further knowledge representations and further inference module.)

Claim 7.

August teaches collecting problem related data from the main system by a service module of a remote service system. (**August,** C5:53-60; 'Remote service system' of applicant is equivalent to 'proxy server' of August.)

August does not teach said problem related data representing a problem identified about data in the main system.

Smith teaches said problem related data representing a problem identified about data in the main system. (**Smith,** C5:23-38; 'Problem identified about data in the main system' of applicant is equivalent to 'diagnosing data communications networks' of Smith.) It would have been obvious to a person having ordinary skill

in the art at the time of applicant's invention to modify the teachings of August by introduction the area of problem related data as taught by Smith to have said problem related data representing a problem identified about data in the main system.

For the purpose of determining if a problem is in database, application server or the front end server.

August teaches acquiring knowledge representations by an acquisition module of the service system, said knowledge representations defining solution identification rules (**August,** C9:66 through C10:27 C14:12-41; 'Acquire knowledge' of applicant is preformed by 'learning engine' of August. 'Defining solution identification rules' of applicant is equivalent to 'definitions of important features' of August.); storing the knowledge representations by a knowledge module of the service system (**August,** C9:66 through C10:27; 'Storing the knowledge representations' of applicant is preformed by 'learning engine' of August.); processing problem related data with the knowledge representations by a inference module to identify solutions (**August,** C19:50 through C20:13; 'inference module' of applicant is equivalent to 'smart search engine' of August.); forwarding the solutions through the service module to the main system. (**August,** C19:50 through C20:13; In FIG #1 the 'smart search engine' forwards solutions through interfaces 26, 24 and 22 to the internet.)

August does not teach applying the identified solutions to solve the problem.

Smith teaches applying the identified solutions to solve the problem. (**Smith,** C30:1-9) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the teachings of August by instructing to perform the solutions to solve the problem as taught by Smith to applying the identified solutions to solve the problem.

For the purpose of correcting the problem.

Claim 9.

August teaches the service system forwards problem data and solutions for further analysis by a human technician. (**August,** C9:66 through C10:27; 'Forwards problem data and solutions' and 'human technician' of applicant is equivalent to 'DB administration' and 'administrator' of August.)

Claim 10.

August teaches the service system forwards problem data and solutions to the further computer in a format that allows analysis by an expert system in the further computer. (**August,** C9:49-54 and C13:52-60; 'Expert system' of applicant is equivalent to 'smart search system' of August.)

Claim 11.

August teaches program code means for performing all the steps of anyone of the claims 7-10 when the computer program product is run on a computer. (**August,** C19:50 through C20:13)

Claim 12.

August teaches an inference module with expertise functionality for evaluating problems (**August,** C19:50 through C20:13; 'inference module' of applicant is equivalent to 'smart search engine' of August.)in a main computer system that executes an application (**August,** C19:50 through C20:13), wherein the inference module is adapted to process problem related data with knowledge representations to identify solutions (**August,** C9:66 through C10:27; 'Process problem' of applicant is equivalent to 'identify' of August.), said knowledge representations defining solution identification rules (**August,** C14:12-41; 'Defining solution identification rules' of applicant is equivalent to 'definitions of important features' of August.), the inference module characterized in that the inference module is part of a service system receiving problem related data from the main computer system over a network. (**August,** FIG#1; 'Inference module' of applicant is equivalent to 'smart search engine' of August. The 'smart search engine' is within the service system which is separated from a main computer system by the internet.)

August does not teach said problem related data representing a problem identified about data in the main system.

Smith teaches said problem related data representing a problem identified about data in the main system. (**Smith,** C5:23-38; 'Problem identified about data in the main system' of applicant is equivalent to 'diagnosing data communications networks' of Smith.) It would have been obvious to a person having ordinary skill

in the art at the time of applicant's invention to modify the teachings of August by introduction the area of problem related data as taught by Smith to have said problem related data representing a problem identified about data in the main system.

For the purpose of determining if a problem is in database, application server or the front end server.

August teaches returning solutions to the main system, wherein in a first case, the service system returns solutions that solve the problem directly (**August,** C9:66 through C10:27; 'Directly' of applicant is equivalent to 'information database'. Directly meaning information that was already at hand and no input from an 'expert' was needed for further search.) and, in a second case, the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module. (**August,** C9:66 through C10:27; 'Indirectly' of applicant is equivalent to 'expert knowledge database'. Indirectly meaning information that was not initially present at system start and learning engine generated a solution caused by further knowledge representations and further inference module.)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 4, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of August, and Smith, as set forth above, and further in view of Babutzka. (U. S. Patent Publication 20020073200, referred to as **Babutzka**)

Claim 2.

August, and Smith fails to particularly call for the main system and the service system communicate through remote function call connections provided by the service module.

Babutzka teaches the main system and the service system communicate through remote function call connections provided by the service module. (**Babutzka,** ¶0099) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combined teachings of August, and Smith by using a system that can contact remote modules as taught by Babutzka to have the main system and the service system communicate through remote function call connections provided by the service module.

For the purpose of providing connections with other modules thus increasing flexibility in design.

Claim 4

August and Smith fails to particularly call for the main system and the service system are systems in client/server configuration.

Babutzka teaches the main system and the service system are systems in client/server configuration. (**Babutzka,** ¶0097) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combined teachings of August and Smith by utilizing a standard client server configuration as taught by Babutzka to have the main system and the service system are systems in client/server configuration.

For the purpose of having the client/server configuration in place allows multiple users to access the system at multiple sites.

Claim 14.

August and Smith fails to particularly call for the main system is implemented as a R/3 system.

Babutzka teaches the main system is implemented as a R/3 system. (**Babutzka,** ¶0009) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combined teachings of August and Smith by using an integrated business system as taught by Babutzka to have the main system is implemented as a R/3 system.

For the purpose of using an industrial standard integrated business system promotes better integration with employees, hardware and software.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of August, and Smith, as set forth above, and further in view of Schoneburg (U. S. Patent Publication 20020133347), and Hennessey (U. S. Patent 6360216).

Claim 8.

August and Bautzka fails to particularly call for identifying the solutions form set of predefined advices of the application, identify the solutions by applying knowledge representations in a sequential order, identify the solutions by applying knowledge representations in a hierarchical order, identify the solutions by applying knowledge representations in a dynamically adaptive order, communicate questions to the user by composing the questions from predefined

passages provided by the application, and analyses responses that the user enters in natural language.

Schoneburg teaches identify the solutions form set of predefined advices of the application, (**Schoneburg,** ¶0075; 'predefined advices' of applicant is equivalent to 'parameters' of Schoneburg.) identify the solutions by applying knowledge representations in a sequential order. (**Schoneburg,** ¶0007; "Sequential order' of applicant is equivalent to 'sequential calling' of Schoneburg.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combination of August and Bautzka by using parameters for search aids and putting the solutions in sequential order as taught by Schoneburg to identify the solutions form set of predefined advices of the application, identify the solutions by applying knowledge representations in a sequential order.

For the purpose of being able to retrieve solutions and put them into a useful best answer first sequence.

Hennessey teaches identify the solutions by applying knowledge representations in a hierarchical order (**Hennessey,** C12:37-50), identify the solutions by applying knowledge representations in a dynamically adaptive order (**Hennessey,** C9:6-26), communicate questions to the user by composing the questions from predefined passages provided by the application (**Hennessey,** abstract; 'Predefined passages' of applicant is equivalent to 'text information from the database' of Hennessey.), and analyses responses that the user enters in natural language. (**Hennessey,** C2:17-24; 'Natural language' of applicant is

equivalent to 'his or her own words' of Hennessey.) It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combined teachings of August and Smith by placing solutions into a hierarchical or dynamic order with aid from the system in the user's own words as taught by Hennessey to identify the solutions by applying knowledge representations in a hierarchical order, identify the solutions by applying knowledge representations in a dynamically adaptive order, communicate questions to the user by composing the questions from predefined passages provided by the application, and analyses responses that the user enters in natural language.

For the purpose of the user having the choice of how solutions are presented and not have to learn the system language for ease of use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of August, and Smith, as set forth above, and further in view of Fujinaga. (U. S. Patent Publication 20010056379, referred to as **Fujinaga**)

Claim 13.

August and Smith do not teach the main system executes an enterprise resource planning application.

Fujinaga teaches the main system executes an enterprise resource planning application. (**Fujinaga,** ¶0014 and ¶0109). It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention to modify the combined teachings of August and Smith by identifying computer problems and attributes as taught by Fujinaga to have the main system executes an enterprise resource planning application.

For the purpose of using the system to operate within all fields of an enterprise.

5. In reference to the Applicant's argument:

Applicant notes that the Examiner's rejection under Section 102(b) is improper since August was published after the effective filing date of this Application.

Examiner's response:

Examiner notes error in non-final rejection. With amendments under consideration this Final Office action is under Section 103(a).

6. In reference to the Applicant's argument:

Resection Under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 1-14 under 35 U.S.C. § 101. Amended independent claim 1 recites, inter alia, "a service module configured to collect problem related data from the main system, said problem related data representing a problem identified about data in the main system" and "an inference module configured to process problem related data with knowledge representations to identify solutions and forward the solutions through the service module to the main system, wherein the identified solutions are applied to solve the problem." The "solutions" recited in amended claim 1 constitute a useful, tangible and concrete result. Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of independent claim 1 under 35 U.S.C. § 101, and claims 2-6, 13 and 14 which depend from claim 1.

Independent claims 7 and 12, although of different scope than claim 1, also recite statutory subject matter. For instance, claim 7 recites, in part, "forwarding the solutions through the service module to the main system; and applying the identified solutions to solve the problem." Further, claim 12 recites, inter a/ia, returning solutions to the main system, wherein in a first case, the service system returns solutions that solve the problem directly and, in a second case, the service system returns solutions that solve the problem indirectly by being further knowledge representations for a further inference module. Thus, independent claims 7 and 12 also recite a useful, tangible and concrete result. Applicant, therefore, respectfully requests that the Examiner reconsider and withdraw the rejection of independent claims 7 and 12, along with claims 8-11 which depend from claim 7.

Examiner's response:

Rejection Under 35 U.S.C. § 101 still stands. See section #4 of this Office Action.

7. In reference to the Applicant's argument:

Reiection of Claims 1, 3, 5-7 and 9-12 Under 35 U.S.C. 102(b)
In order for August to anticipate Applicant's claimed invention under Section 102(b), each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in the reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." (See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).) August fails to anticipate claim 1 because August does not to disclose, expressly or otherwise, each and every feature recited in claim 1.

As amended, claim 1 recites, inter alia, "a service module configured to collect problem related data from the main system, said problem related data representinq a problem identified about data in the main system... an acquisition module configured to acquire knowledge representations, said knowledge representations defining solution identification rules... [and] processing problem related data with the knowledge representations by a inference module to identify solutions" (emphasis added).

August is directed toward a data search engine providing improved means for locating information stored on a plurality of network servers. (August, Cols. 1:7-12, 3:37-53.) However, August is silent with regard to the "problem related data representing a problem identified about the data in the main system," or the "knowledge representations comprising predefined solution identification rules," as recited in amended claim 1. Since August fails to disclose at least these features of claim 1, the reference also does not teach "processing problem related data with the knowledge representations by a inference module to identify solutions." Accordingly, August fails to anticipate claim 1. Applicant, therefore, respectfully requests that the Examiner withdraw of the rejection of independent claim 1 under 35 U.S.0 § 102(b), as well as claims 3, 5, and 6 at least due to their dependence from claim 1.

Amended claims 7 and 12, although of different scope than claim 1, also recite patentable subject matter like claim 1. For example, claims 7 and 12 include limitations related to "problem related data" and "knowledge representations." As discussed with regard to claim 1, August fails to teach these features. Accordingly, for at least the same reasons as discussed above in regard to claim 1, August also cannot anticipate claims 7 and 12 under 35 U.S.C. §102(b). Moreover, August fails to anticipate claims 9-11 at least due to the dependence of these claims from independent claim 7.

Examiner's response:

Rejection is now under section 103(a). Smith illustrates "problem related data representing a problem identified about the data in the main system,". August teaches 'Defining solution identification rules' of applicant is equivalent to 'definitions of important features' of August and 'Inference module' of applicant is equivalent to 'smart search engine' of August.

8. In reference to the Applicant's argument:

Rejection of Claims 2, 4, 8, 13 and 14 Under 35 U.S.C. 103(a).
In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art references must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143. Here, the cited references cannot support a rejection under 35 U.S.C. §103 because, among other things, August, Babutzka, Schoneburg, Hennessey or Fujinaga, taken alone or in any proper combination, do not disclose teach or suggest each and every feature recited in Applicant's claims 1 and 7.

As noted above with regard to claim 1, August does not disclose or suggest "a service module configured to collect problem related data from the main system, said problem related data representing a problem identified about data in the main system... an acquisition module configured to acquire knowledge representations, said knowledge representations defining solution identification rules... [and] processing problem related data with the knowledge representations by a inference module to identify solutions." Similar features are also recited in claim 7, which are neither taught nor suggested by August. None of Babutzka, Schoneburg, Hennessey or Fujinaga overcome these shortcomings of August.

The Examiner apparently cites Babutzka for its teaching of "remote function call connections." (Office Action, p. 9:1-6.) Schoneburg and Hennessy are cited by the Examiner together for allegedly disclosing "identifying the solutions [from a] set of predefined advices of the application, identify[ing] the solutions by applying knowledge representations in a sequential order, identify[ing] the solutions by applying knowledge representations in a hierarchical order, identify[ing] the

solutions by applying knowledge representations in a dynamic adaptive order, communicat[ing] to the user by composing questions from predefined passages provided by the application, and analyses responses that the user enters in a natural language." (Office Action, pp. 10:19-11:5.) Fujinaga supposedly discloses "an enterprise resource planning application." (Office Action, p. 13:1-5.) However, Babutzka, Schoneburg, Hennessey or Fujinaga do not disclose or suggest the above-noted "problem related data" or "knowledge representations," as recited in claims 1 and 7. Nor does the Examiner assert that Babutzka, Schoneburg, Hennessey or Fujinaga disclose such features.

Accordingly, August, Babutzka, Schoneburg, Hennessey or Fujinaga, taken alone or in any proper combination, do not teach or suggest each and every feature recited in Applicant's independent claims 1 and 7 and, therefore, cannot support a rejection of these claims under 35 U.S.C. § 103(a). Dependent claims 2, 4, 8, 13 and 14 are therefore allowable at least due to their corresponding dependence from claims 1 and 7.

Examiner's response:

Smith illustrates "problem related data representing a problem identified about the data in the main system". In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is not what individual references themselves suggest but rather what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Keller, 648 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

Conclusion

9. The prior art of record and not relied upon is considered pertinent to the applicant's disclosure.

-U. S. Patent Publication 20020165724: Blankesteijn

-U. S. Patent Publication 20020095399: Devine

-U. S. Patent 6463470: Mohaban

-U. S. Patent Publication 20020198858: Stanley

-U. S. Patent Publication 20020069134: Soloman

-U. S. Patent 6173347: Emmerich

-U. S. Patent 6105016: Martin

-U. S. Patent 5896510: Kanayama

-U. S. Patent Publication 20020002603: Vange

10. Claims 1-14 are rejected.

Correspondence Information

11. Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner Peter Coughlan, whose telephone number is (571) 272-5990. The Examiner can be reached on Monday through Friday from 7:15 a.m. to 3:45 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor David Vincent can be reached at (571) 272-3687. Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

Hand delivered to:

Receptionist,

Customer Service Window,

Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 273-8300 (for formal communications intended for entry.)

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more

information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Peter Coughlan

2/8/2006